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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/901,305	07/09/2001	Wayne Anderson	P-14 (n) CIP / CONT	8578
28752	7590	04/20/2004		
LACKENBACH SIEGEL, LLP LACKENBACH SIEGEL BUILDING 1 CHASE ROAD SCARSDALE, NY 10583			EXAMINER MEISLIN, DEBRA S	
			ART UNIT 3723	PAPER NUMBER 25

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/901,305

Applicant(s)

ANDERSON ET AL.

Examiner

Debra S Meislin

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 92,95,97 and 102-105 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 92,95,97 and 102-105 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. Claims 92, 95, 97 and 104 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 92, line 15, "adjacent closed end" should be --adjacent said closed end--.

In claim 97, the terminology is not consistent with the terminology used in claim 92. In claim 92, lines 2-3 now define "tool bit member comprising a hexagonal body and a double ended drive bit". Claim 97 defines "said tool bit member comprising a double-ended tool bit". Claim 97 appears to be redundant in view of claim 92.

Clarification is required.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 92, 95, 97 and 102-106 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrison et al (6,009,582) in view of Beran (2,980,996) and Park (5,280,659).

Figure 17 of Harrison et al discloses all of the claimed subject matter except for a closed-ended sleeve being non-removably connected to the handle, the sleeve being pivotable to an inoperative position between the handle sides, and the bit in the sleeve being stored in the handle. Beran discloses a sleeve (36 or 51) having a closed end non-removably connected to the handle and being pivotable to an inoperative position between the handle sides. It would have been obvious to one having ordinary skill in

Art Unit: 3723

the art to form the sleeve of Harrison et al with a closed end non-removably connected to the handle and being pivotable to an inoperative position between the handle sides to store the sleeve out of the way and such it may be readily available for use in a single device as taught by Beran. Note column 1, lines 28-36 and column 4, lines 37-47 which state the following:

It is accordingly a particular object of the present invention to provide in one unit or one device a combination of different tools or implements which are associated with one another so that they may be readily selected for use but wherein the various tools or implements are also so assembled or connected together that when one is in use the others are covered or shielded and are out of the way and will not interfere with or hamper the user.

From the foregoing it will be seen that there is provided by the present invention a combination tool of new and novel construction which provides in addition to the several cutting implements which are pivoted to be closed in the slots of the body, the novel handle body side plates in the form of rasps or cutting implements, and the novel pivoted adapters which facilitate the easy removal and replacement of the cutting implements and which when attached to the cutting implements form an integral part thereof to be closed with the implements in the receiving slots.

Beran further discloses tool implements (42 or 56) within the sleeves (36 or 51) for storage within the handle. It would have been obvious to one having ordinary skill in the art to form the device of Harrison et al such that the tool implement and sleeve thereof are stored within the handle to allow for the storage of the tool implement within the handle for storage out of the way and such it may be readily available for use in a single device as taught by Beran. Note column 1, lines 28-36 and column 4, lines 37-47, above.

Art Unit: 3723

With respect to claim 102, note that the sleeve of Harrison et al is cylindrical and has a wing member (118) "having oppositely disposed flat surfaces extending away from the outside of the tubular body" as broadly claimed by applicant. Beran additionally discloses a body formed with a wing member having oppositely disposed flat surfaces extending away from the outside of the body as broadly claimed by applicant. Note figure 6 of Beran.

Park discloses a double-ended tool bit (33). It would have been obvious to one having ordinary skill in the art to form the bit of Harrison et al as double-ended to allow for added versatility to improve efficiency as taught by Park. See figure 5 of Park and column 1, lines 5-42 which state the following:

Art Unit: 3723

The present invention relates to a manual tool, and more particularly to a multipurpose manual tool which used in many kinds of works so as to improve the operation efficiency. 5

Manual tools are generally used in pounding, stripping a covering, fixing, cutting or turning a work material and the like. 10

A hammer is used as a pounding tool. A nipper and scissors are used as stripping and cutting tools. A vice is used as a fixing tool. Plier, wrench and screwdriver are used as turning tools. 15

These tools are selectively used according to the kinds of works, and have been manufactured individually.

Thus, in case of using a certain tool, if all of the above tools are not prepared, the work can not be performed or can not help being delayed. 20

Furthermore, it is difficult to carry all of them in one keeping box due to the weight of the tools and also it is easy to lose them during keeping or using.

In addition, it is not easy to prepare all of these tools owing to the economic burden. 25

SUMMARY OF THE INVENTION

An object of the present invention is to provide a multipurpose tool which performs various kinds of works conveniently and quickly, and which is easy to keep and carry. 30

Another object of the present invention is to provide a multipurpose tool which is inexpensive and thus can be used as a house hold tool. 35

According to the present invention, the multipurpose tool comprises a pair of movable members having handle sections at one end thereof and working edges which are crisscross with each other and being hinged together by a pin, and four working stations having the working edges, the working edges being folded or unfolded about the pivot pin. 40

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Applicant's arguments filed February 5, 2004 have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

The device of Harrison would not be rendered inoperable by the teachings of Beran since such a combination merely substitutes a separable structure with an integral (fixed) structure and eliminates the function of the screwdriver bit (166). The device of Harrison would remain operable as a multiple function tool. Note MPEP 2144.04(II) and (V) which indicate that an element may be eliminated with its function and separable elements may be formed as integral.

It is noted that Beran was not applied to the rejection of the claims to teach the concepts as provided by the primary reference to Harrison. Beran was applied to the rejection of the claims to teach the concepts of a sleeve having a closed end non-removably connected to the handle and being pivotable to an inoperative position between the handle sides and tool implements within the sleeves for storage within the handle.

In response to applicant's arguments throughout the response (e.g., pages 10, 13, and 17-19), the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). The combined teachings of Harrison and Beran clearly suggest the claimed subject matter as set forth, above.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching, suggestion, or motivation to do is found in the references themselves as defined in paragraph 3, above, and as repeated herein.

It would have been obvious to one having ordinary skill in the art to form the sleeve of Harrison et al with a closed end non-removably connected to the handle and being pivotable to an inoperative position between the handle sides to store the sleeve out of the way and such it may be readily available for use in a single device as taught by Beran. Note column 1, lines 28-36 and column 4, lines 37-47.

It would have been obvious to one having ordinary skill in the art to form the device of Harrison et al such that the tool implement and sleeve thereof are stored within the handle to allow for the storage of the tool implement within the handle for storage out of the way and such it may be readily available for use in a single device as taught by Beran. Note column 1, lines 28-36 and column 4, lines 37-47, above.

Art Unit: 3723

It would have been obvious to one having ordinary skill in the art to form the bit of Harrison et al as double-ended to allow for added versatility to improve efficiency as taught by Park. See figure 5 of Park and column 1, lines 5-42.

With respect to the wing member, the sleeve of Harrison et al is cylindrical and has a wing member (118) "having oppositely disposed flat surfaces extending away from the outside of the tubular body" as broadly claimed by applicant. Beran additionally discloses a body formed with a wing member having oppositely disposed flat surfaces extending away from the outside of the body as broadly claimed by applicant. It is noted that applicant has failed to define "the outside" of the tubular body. As claimed, the tubular body includes the end thereof. The wing of Harrison, when connected to the tubular body, clearly extends from "the outside" thereof, as broadly claimed. In the combination of Harrison as modified by Beran, the wing is non-removably connected to the body.

The term "bits" has been replaced with more appropriate terminology. The device of Beran includes "tool implements" (42 or 56) within the sleeves (36 or 51).

Applicant's arguments based upon MPEP 2144.03 are not on point since MPEP 2144.03 is directed to the procedure for relying on common knowledge or taking official notice. The examiner has not relied on common knowledge or official notice and no such statements were made. The examiner has provided proper teachings or reasons to modify the references as discussed, above.

Applicant's statement "...in addition to the later date of Harrison, voiding Harrison as a reference..." is inaccurate. Harrison has an effective filing date of October 29, 1996. Applicant's claimed invention has an effective filing date of August 1, 1997. Any earlier filing dates of the parent applications do not cover the claimed subject matter.

Applicant's arguments based upon MPEP 2144.08 are not on point since MPEP 2144.08 is directed to obviousness of species when prior art teaches genus. The applied rejection of the claims are not directed to obviousness of species when prior art teaches genus.

The teachings of Harrison need not be suggested by Beran and visa versa. If such were the case, the claims would have been rejected under 35 USC 102. The applied rejections were based upon 35 USC 103 and not 35 USC 102.

Applicant's statement "Since Harrison is not applicable as blocking art" is not understood.

Applicant's arguments based upon MPEP 2145(I) are not on point since MPEP 2145(I) is directed to the consideration of applicant's rebuttal arguments and not to the examiners arguments.

Applicant's arguments based upon MPEP 2163.04 are not on point since MPEP 2163.04 is directed to the burden on the examiner with regard to the written description. Since the rejection does not refer to the written description in any way, such arguments are not understood.

Applicant's arguments are replete with improper citations of the MPEP. Such citations render the arguments, based thereon, moot.

It is noted that the reason for amending the claims does not preclude the possibility of the amendment narrowing the scope of the claims.

Art Unit: 3723

6. The status of the parent applications must be updated on page 1 of the specification. The updated status must include the patent numbers for any patented application.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra S Meislin whose telephone number is 703 308-3671. The examiner can normally be reached on M-F, alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 703 308-2687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Debra S Meislin
Primary Examiner
Art Unit 3723

April 14, 2004